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09/385,802	08/30/1999	KEVIN REMINGTON JOSEPH BARTHOLOMEN DONOVAN	4031/1	9671

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EXAMINER
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CHANKONG, DOHM

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2452

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/385,802	<b>Applicant(s)</b> BARTHOLOMEN DONOVAN, KEVIN REMINGTON JO	
	<b>Examiner</b> DOHM CHANKONG	<b>Art Unit</b> 2452	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 16-20,22,103 and 105-151 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-20,22,103 and 105-151 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/1/08</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to Applicant's request for continued examination. No claims are amended. Claims 16-20, 22, 103 and 105-151 are presented for further examination.
2. This action is a non-final rejection.

#### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/1/2008 has been entered.

#### ***Oath/Declaration***

4. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective dates of the Auerbach, Aravamudan, and Gudjonsson references. Applicant's declares that an "embodiment of the invention" was completed prior to the effective dates of the aforementioned references. In support of this declaration, Applicant presents a Business Wire article as evidence of the commercial release of the embodiment of the invention. While the article discusses in broad strokes the release of a software application that is compatible with multiple IM platforms, this article fails to provide any support for the limitations in the claims. At best, the article simply

Art Unit: 2452

supports the notion that a Beta version of an instant messaging application that was *capable* of communicating with multiple IM platforms was released on May 5, 1999. There is however no evidence that the specific limitations at issue in the claims were actually reduced to practice on that date. For example, the evidence does not discuss determining a current IP address of a second user, establishing connections between a first and second user using the current IP address and protocol characteristic of the user, or encrypting the instant message. Therefore, the evidence is insufficient to establish that the claimed invention was actually reduced to practice prior to the Auerbach, Aravamudan, and Gudjonsson references. Because Applicant's declaration under 35 CFR 1.131 is insufficient, the Auerbach, Aravamudan, and Gudjonsson references still qualify as prior art. The rejection set forth in the previous rejection are maintained.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 112 and 113 are rejected under 35 U.S.C §102(e) as being anticipated by Auerbach et al, U.S Patent No. 6.549.937 ["Auerbach"].

Art Unit: 2452

6. As to claim 112, Auerbach discloses a method of conducting an instant messaging session between a first user and a second user over the Internet, the method comprising the steps of:

retrieving an instant messaging protocol suitable for communications with said second user from a database accessible to the first user [Figure 2 «item 112» | column 5 «lines 27-37» | column 7 «lines 10-28» where : Auerbach's conversion platform 112 reads on Applicant's claimed database]; and

establishing a connection from said first user to said second user using the instant messaging protocol as part of an instant messaging session [column 7 «line 65» to column 8 «line 40»].

7. As to claim 113, Auerbach discloses a method of conducting an instant messaging session between a first user and a second user over the Internet, the method comprising the steps of:

retrieving one of a plurality of instant messaging protocols, the one instant messaging protocol being suitable for communications with said second user from a database accessible to the first user [Figure 2 «item 112» | column 5 «lines 27-37» | column 7 «lines 10-28» where : Auerbach's conversion platform 112 reads on Applicant's claimed database];

displaying an instant message from said first user to said second user using the instant messaging protocol [column 7 «line 65» to column 8 «line 40»].

Art Unit: 2452

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16-20, 22, 103, 105-111, and 114-127 are rejected under 35 U.S.C § 103(a) as being unpatentable over Aravamudan et al, U.S Patent No. 6.301.609 [“Aravamudan”], in view of Gudjonsson et al, U.S Patent No. 6.564.261 [“Gudjonsson”].

9. As to claim 16, Aravamudan discloses a method of conducting an instant messaging session between a first user and a second user over the Internet, the method comprising:  
associating said first and second users with a first realm and second realm respectively [Figure 3 «items 184 and 192»], each said realm being accessible via the Internet using a protocol characteristic to said realm [column 5 «lines 32-51» | column 7 «lines 3-20» where : if a PSTN network, for instance, a PSTN exchange number is used], each said user getting access to the Internet via one of a respective first and second device [Figure 2], at least one of said first and second devices having a storage media storing the protocol characteristic of the other realm [column 7 «lines 3-20» | column 12 «lines 9-30»];

determining a current IP address of the second user [column 4 «lines 3-25» | column 9 «lines 50-57»];

establishing a connection between said first and second users using said current IP

Art Unit: 2452

address and said protocol characteristic as part of an instant messaging session [column 9 «lines 45-57» | column 11 «lines 8-45»].

Aravamudan does not expressly disclose encrypting instant messages. In a related field of invention Gudjonsson is directed towards establishing communication sessions between users over a variety of networks. Gudjonsson discloses encrypting, as between the devices, an instant message during the instant message session [abstract | column 2 «lines 16-23» | column 11 «lines 38-43» where : Gudjonsson discloses brokering communication services between two or more users. Gudjonsson also discloses that each device has encrypted communications to its server.

Therefore, when a first device sends a message to a second device, the message is encrypted between the first device to the server and from the server to the second device]. It would have been obvious to one of ordinary skill in the art to incorporate encryption services into Aravamudan's communication system for the desirable function of having secured transmissions of network messages between users.

10. As to claim 17, Aravamudan discloses sending a message to the IM database indicating the corresponding user is online [column 9 «line 64» to column 10 «line 15»].

11. As to claim 18, Aravamudan discloses retrieving said address form said IM database [column 5 «lines 25-31» | column 6 «lines 18-31» | column 9 «lines 49-57»].

12. As to claim 19, Aravamudan discloses sending a connection request from the first to the second device for establishing said instant messaging session [column 9 «lines 10-22»].

13. As to claim 20, Aravamudan discloses generating a response to said connection request by said second device accepting said connection request [column 9 «lines 10-22» | column 10 «lines 37-44» | column 11 «lines 35-45»].

14. As to claim 22, Aravamudan discloses displaying a window on the screen of said first and second devices, said window indicating a list of active users [column 6 «lines 18-31»].

15. As to claim 103, Aravamudan discloses displaying a window with a message area, said message area being used to indicate messages between said users [column 10 «lines 37-41»].

16. As to claims 105 and 106, Aravamudan discloses a handheld and a palmtop computer [Figure 2].

17. As to claim 107, Aravamudan does not expressly disclose a WebTV device. However, Aravamudan states that his invention is not limited to the disclosed devices, and is relevant to any data or communication devices synchronized with a network means [column 3 «lines 26-37»]. As a WebTV device is well known in the art, it would have been obvious to one of ordinary skill in the art to incorporate such devices into Aravamudan's network communication system to increase the number of devices with which he is compatible. Furthermore, selection of network devices is merely a design choice and does not provide any patentable distinction over the prior art references.



18. As to claim 108, Aravamudan discloses a method of conducting an instant messaging session, the method comprising:

establishing an instant messaging session over an Internet protocol network between a first user device and a second user device [column 3 «lines 26-52»], each said user device corresponding to a user name [column 6 «lines 50-63.], each said user name corresponding to a different realm [column 6 «lines 27-29 and 50-67» | column 7 «lines 9-20»], each said user device having an Internet protocol address in the realm corresponding to the user name [column 4 «lines 20-25» | column 9 «lines 49-57»].

19. Aravamudan does not expressly disclose encrypting instant messages.

In a related field of invention Gudjonsson is directed towards establishing communication sessions between users over a variety of networks. Gudjonsson discloses encrypting, as between devices, an instant message during the instant message session [abstract | column 2 «lines 16-23» | column 11 «lines 38-43»]. It would have been obvious to one of ordinary skill in the art to incorporate encryption services into Aravamudan's communication system for the desirable function of having secured transmissions of network messages between users.

20. As to claims 109-111, as they do not teach or further define over the previously claimed rejections, they are similarly rejected for at least the same reasons set forth for claims 105-107.

Art Unit: 2452

21. As to claim 114, Aravamudan discloses an instant message receiving system, said system including:

a first user device connected to an Internet Protocol Network and associated with a first Internet Protocol address, a first user name, and a first realm [column 3 «line 26» to column 4 «line 25»]; and

a second user device connected to said Internet Protocol Network and associated with a second Internet Protocol address, a second user name, and a second realm [column 3 «line 26» to column 4 «line 25» | column 7 «lines 3-20»];

Aravamudan does not expressly disclose encrypting instant messages but encryption of network data is rather ubiquitous and even expected in the art, as evidenced by Gudjonsson.

In a related field of invention Gudjonsson is directed towards establishing communication sessions between users over a variety of networks. Gudjonsson discloses encrypting an instant message during the instant message session [abstract | column 2 «lines 16-23» | column 11 «lines 38-43»]. It would have been obvious to one of ordinary skill in the art to incorporate encryption services into Aravamudan's communication system for the desirable function of having secured transmissions of network messages between users.

22. As to claims 115-117, as they do not teach or further define over the previously claimed rejections, they are similarly rejected for at least the same reasons set forth for claims 105-107.

Art Unit: 2452

23. As to claims 118-121, as they do not teach or further define over the previously claimed limitations they are similarly rejected for at least the same reasons set forth above for claims 104 and 108-117.

24. As to claims 122 and 125, Aravamudan discloses said first realm employs a first protocol characteristic [column 7 «lines 3-20» : one user can be in a packet network, thus Aravamudan discloses a characteristic that marks the user as being in a packet network], said second realm employs a second protocol characteristic [column 7 «lines 3-20» : another user can be in a PSTN network, thus Aravamudan discloses a characteristic that marks the user as being in a PSTN network], and wherein said first protocol characteristic is different from said second protocol characteristic [PSTN vs. packet network].

25. As to claims 123, 124, 126 and 127, as they do not teach or further define over previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 17 and 22.

26. Claims 114-117 and 122-124 are rejected as being unpatentable over Aravamudan, in view of Shah et al, U.S Patent No. 6.606.647 [“Shah”].

27. As to claim 114, Aravamudan discloses an instant message receiving system, said system including:

a first user device connected to an Internet Protocol Network and associated with a

Art Unit: 2452

first Internet Protocol address, a first user name, and a first realm [column 3 «line 26» to column 4 «line 25»]; and

a second user device connected to said Internet Protocol Network and associated with a second Internet Protocol address, a second user name, and a second realm [column 3 «line 26» to column 4 «line 25» | column 7 «lines 3-20»];

Aravamudan does not expressly disclose key-encrypted instant messages. Shah is directed towards routing messages to achieve unified communications. Shah discloses sending an receiving key-encrypted instant messages between a first user device and a second user device [abstract | column 5 «lines 14-21» | column 6 «lines 15-20» | column 7 «lines 37-42» where : Shah discloses message encryption and sending an encryption key of the receiving device to the sending device. These two features strongly imply that the message is encrypted using the encryption key].

It would have been obvious to one of ordinary skill in the art to modify Aravamudan to incorporate Shah's message encryption key functionality. One would have been motivated to provide such a modification to improve Aravamudan's instant messaging system by providing message encryption.

28. As to claims 115-117, as they do not teach or further define over the previously claimed rejections, they are similarly rejected for at least the same reasons set forth for claims 105-107.

29. As to claim 122, Aravamudan discloses said first realm employs a first protocol characteristic [column 7 «lines 3-20» : one user can be in a packet network, thus Aravamudan

Art Unit: 2452

discloses a characteristic that marks the user as being in a packet network], said second realm employs a second protocol characteristic [column 7 «lines 3-20» : another user can be in a PSTN network, thus Aravamudan discloses a characteristic that marks the user as being in a PSTN network], and wherein said first protocol characteristic is different from said second protocol characteristic [PSTN vs. packet network].

30. As to claims 123 and 124, as they do not teach or further define over previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 17 and 22.

31. Claims 16, 22, 105-108, 118, 122, 125 and 149 are rejected under 35 U.S.C § 103(a) as being unpatentable over Auerbach in view of Kim, U.S Patent No. 6.490.274 [“Kim”], in further view of Gudjonsson.

32. As to claim 16, Auerbach discloses a method of conducting an instant messaging session between a first user and a second user over the Internet, the method comprising:

associating said first and second with a first realm and a second realm respectively [column 2 «lines 9-15» : different users, different service providers], each realm being accessible via the Internet using a protocol characteristic to the realm (col. 2, lines 19-28), each said user getting access to the Internet via one of a respective first and second device (fig. 3, client 102), at least one of said first and second devices having a storage media storing the protocol characteristic of the other realm (see fig. 3, protocol services 130 and 132);

Art Unit: 2452

establishing a connection between said first and second users [column 7 «line 65» to column 8 «line 27»].

While Auerbach discloses the user logging on to the primary service provider using established logon procedures, and Auerbach does not specifically disclose the steps of determining a current IP address of the second user, and establishing a connection between the first and second users using the current IP address and the protocol characteristic. As discussed previously, the use of IP addresses to connect network users is implicit in Auerbach. Auerbach clearly discloses establishing network sessions between the users through his conversion platform; the platform would necessarily need to know the IP addresses of each user to do so. Further, Auerbach discloses establishing sessions based on the email addresses of users [column 1 «lines 46-61»]. It is well known in the art that email addresses are inherently tied to IP addresses.

Auerbach does not expressly disclose encrypting instant messages. In a related field of invention Gudjonsson is directed towards establishing communication sessions between users over a variety of networks. Gudjonsson discloses encrypting an instant message, as between devices, during the instant message session [abstract | column 2 «lines 16-23» | column 11 «lines 38-43» where: Gudjonsson's servers are interpreted as Applicant's "devices"; see also response to Applicant's remarks above]. It would have been obvious to one of ordinary skill in the art to incorporate encryption services into Auerbach's communication system for the desirable function of having secured transmissions of network messages between users.

Furthermore, the step of searching for IP addresses and utilizing said IP addresses are well known in the art as evidenced by Kim. In similar art, Kim discloses a peer-to-peer telephony

Art Unit: 2452

system for supplying service using a cable network that discloses when a first or second cable phone initiates a call, the network segment units each have a head end unit that read IP addresses stored in the directory unit based on a received telephone number of a second cable phone and determines a session using an internet protocol from the read IP addresses to set a call path with the first cable phone (see Kim, abstract and col. 4, lines 56-65). It would have been obvious to supplement the system disclosed by Auerbach to include the IP address database taught by Kim in order to allow the user to connect to and engage particularly in instant messaging sessions regardless of their different protocol or service providers used. As Auerbach suggests searching for the email addresses of users to establish communication sessions, utilization of Kim's IP address database would have been an obvious modification to the system disclosed by Auerbach.

33. In considering claim 22, Auerbach discloses displaying a window on the screen of the first and second devices, the window indicating a list of active users (see Fig 4B).

34. As to claims 105-107, Auerbach discloses a handheld and palmtop computer [column 3 «lines 32-37»] and a WebTV device [column 3 «lines 32-37» : “consumer electronics”].

35. As to claim 108, Auerbach discloses a method of conducting an instant messaging session, the method comprising:

establishing an instant messaging session over an Internet protocol network between a first user device and a second user device [column 1 «lines 46-61»], each said user device corresponding to a user name [Figures 4A, 4B.], each said user name corresponding to a different

Art Unit: 2452

realm [column 2 «lines 26-32»] , each said realm having a protocol characteristic to the realm [Figure 4B | column 2 «lines 26-32»].

Auerbach does not expressly disclose each said user device having an Internet protocol address in the realm corresponding to the user name. As discussed previously, the use of IP addresses to connect network users is implicit in Auerbach. Auerbach clearly discloses establishing network sessions between the users through his conversion platform; the platform would necessarily need to know the IP addresses of each user to do so. Further, Auerbach discloses establishing sessions based on the email addresses of users [column 1 «lines 46-61»]. It is well known in the art that email addresses are inherently tied to IP addresses.

Auerbach does not expressly disclose encrypting instant messages but see rejection of claim 16 above.

36. As to claims 118, as it does not teach or further define over the previously claimed limitations it is similarly rejected for at least the same reasons set forth above for claims 108 and 112.

37. As to claims 122 and 125, Auerbach discloses said first realm employs a first protocol

38. characteristic, said second realm employs a second protocol characteristic, and wherein said first protocol characteristic is different from said second protocol characteristic [claim 1]

39. As to claim 149, Auerbach discloses said realms comprise Internet service providers [abstract].



Art Unit: 2452

40. Claims 114-117 and 125 are rejected as being unpatentable over Auerbach and Kim, in view of Shah.

41. As to claim 114, Auerbach disclose an instant message receiving system, said system including:

a first user device connected to an Internet Protocol Network and associated with a first Internet Protocol address, a first user name, and a first realm [Auerbach, claim 1 & Kim, abstract]; and

a second user device connected to said Internet Protocol Network and associated with a second Internet Protocol address, a second user name, and a second realm [Auerbach, claim 1 & Kim, abstract];

Auerbach does not expressly disclose key-encrypted instant messages.

42. Shah is directed towards routing messages to achieve unified communications. Shah discloses sending an receiving key-encrypted instant messages between a first user device and a second user device [abstract | column 5 «lines 14-21» | column 6 «lines 15-20» | column 7 «lines 37-42» where : Shah discloses message encryption and sending an encryption key of the receiving device to the sending device. These two features strongly imply that the message is encrypted using the encryption key].

It would have been obvious to one of ordinary skill in the art to modify Auerbach

Art Unit: 2452

to incorporate Shah's message encryption key functionality. One would have been motivated to provide such a modification to improve Auerbach's instant messaging system by providing message encryption.

43. As to claims 115-117, Auerbach discloses a handheld and palmtop computer [column 3 «lines 32-37»] and a WebTV device [column 3 «lines 32-37» : "consumer electronics"].

44. As to claim 125, Auerbach discloses said first realm has a protocol and said second realm has a protocol, said protocols being different [claim 1].

45. Claims 17-20, 103, 123, 124, 126 and 127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auerbach, Gudjonsson and Kim, in view of Appelman, U.S. Patent No. 6.750.881.

46. In considering claim 17, while the combined system of Auerbach and Kim discloses the system substantially as claimed, it does not disclose that sending a message to the IM database indicating the corresponding user is online. Nonetheless, the aforementioned limitation is a well-known feature of instant messaging systems as evidenced by Appelman.

In similar art, Appelman discloses a real time notification system that tracks, for each user, the logon status of selected co-users. Appelman further discloses that when a user logs on the logon system notifies the Buddy List System about the user (i.e. passes the User's ID, address, or screen name to the Buddy List System) (see Appelman col. 6, lines 57-5%. It would

Art Unit: 2452

have been obvious to modify the combined system of Auerbach and Kim to include the steps of sending a message to an IM database indicating the corresponding user is online and the current IP address in order to more accurately track user relationships and maintain knowledge of the users and processes on the system. Therefore, the limitations would have been an obvious modification to the combines system of Auerbach and Kim.

47. In considering claim 18, the combined system of Auerbach, Kim, and Appelman discloses wherein the step of determining the current P address comprises retrieving the address from the IM database (see Kim col. 4, lines 56-61).

48. In considering claim 19, Auerbach discloses sending a connection request from the first to the second device for establishing the instant message session (see Auerbach col. 11 lines 48-50).

49. In considering claim 20, Auerbach discloses generating a response to the connection  
50. request by the second device accepting the connection request (see Auerbach col. 11, lines 1-3).

51. In considering claim 103, Auerbach discloses displaying the window with a message area the message area being used to indicate messages between users (see Appelman Fig. 9).

Art Unit: 2452

52. As to claims 123, 124, 126 and 127, as they do not teach or further define over previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 17 and 22.

53. Claims 128-130, 132-134, 136-146, 150 and 151 are rejected under 35 U.S.C §103(a) as being unpatentable over Auerbach, in view of Shah.

54. As to claims 128 and 129, Auerbach discloses a system for instant messaging, the system including:

a first Internet service provider [abstract : sender and recipient each having different service providers];

a second Internet service provider [abstract : recipient's service provider;

a user name associated with the first Internet service provider [column 5 «lines 49-62»]; and

a second user name associated with the second Internet service provider [column 5 «lines 49-62»];

wherein each said user name corresponds to a respective device enabled to conduct an instant messaging session over the Internet [column 4 «lines 20-33» | column 5 «lines 49-62»].

Auerbach does not expressly disclose that said instant messaging session is encrypted as between the devices or that the devices are enabled by a prior communication of an encryption key.

Art Unit: 2452

55. Shah is directed towards routing messages to achieve unified communications. Shah discloses sending an receiving key-encrypted instant messages between a first user device and a second user device, the encryption key being sent in a prior communication [abstract | column 5 «lines 14-21» | column 6 «lines 15-20» | column 7 «lines 37-42» where : Shah discloses message encryption and sending an encryption key of the receiving device to the sending device. These two features strongly imply that the message is encrypted using the encryption key].

It would have been obvious to one of ordinary skill in the art to modify Auerbach to incorporate Shah's message encryption key functionality. One would have been motivated to provide such a modification to improve Auerbach's instant messaging system by providing message encryption.

56. As to claims 130 and 134, Auerbach discloses the instant messaging session facilitated by forming a relay connection [column 4 «lines 34-50»].

57. As to claims 132, 133, 136, 137, Auerbach discloses a portal instant messaging provider and a general instant messaging provider [column 5 «lines 11-37»].

58. As to claims 138-143 Auerbach discloses handheld and palmtop computers [column 3 «lines 32-37»] and a WebTV device [column 3 «lines 32-37» : "consumer electronics"].

59. As to claim 144, Auerbach discloses the system further including:  
a third Internet service provider [column 5 «lines 16-20»]; and

Art Unit: 2452

a third user device associated with a user name at the third Internet service provider, wherein the third user device participates in the instant messaging session [column 5 «lines 11-62»].

Auerbach does not expressly disclose that said instant messaging session is encrypted as between the devices but see rejection of claim 128 above.

60. As to claim 145, Auerbach discloses the first device displays a friends list including the Internet service provider of the second user and a user name of the second user and the Internet service provider of the third user and the user name of the third user [column 5 «lines 54-59» | column 6 «lines 14-42»].

61. As to claim 146, Auerbach discloses retrieving an instant messaging protocol suitable for communications with said second user from a database accessible to the first user [Figure 2 «item 112» | column 5 «lines 27-37» | column 7 «lines 10-28» where : Auerbach's conversion platform 112 reads on Applicant's claimed database].

62. As to claims 150 and 151, see rejection of claims 128 above.

63. Claims 131 and 135 are rejected under 35 U.S.C §103(a) as being unpatentable over Auerbach and Shah in view of DeSimone et al, U.S Patent No. 6,212,548 [“DeSimone”].

Art Unit: 2452

64. As to claims 131 and 135, Auerbach does not teach peer-to-peer connections but does teach that the invention may be practiced in “distributed computing environments.” DeSimone discloses establishing peer-to-peer connections for instant messaging [Figure 2B | Figure 3 | column 4 «line 57» to column 5 «line 5»]. It would have been obvious to incorporate peer-to-peer methodology into Auerbach’s instant messaging system as taught by DeSimone. One would have been motivated to provide such a combination as peer-to-peer messaging reduces burden on servers [see DeSimone, abstract].

65. Claims 147 and 148 are rejected under 35 U.S.C §103(a) as being unpatentable over Auerbach and Shah, in view of Aravamudan.

66. As to claim s147 and 148, Auerbach does not expressly disclose a service provider providing Internet telephone service.

67. Aravamudan discloses an internet service provider providing Internet telephone service and establishing a connection with an Internet service provider that provides Internet telephone service [column 3 «lines 26-66» : “Internet Protocol (IP) telephony” | column 4 «lines 6-25»]. It would have been obvious to one of ordinary skill in the art to incorporate IP telephony devices and service providers into Auerbach’s unified messaging system as IP telephony and telephony service providers were well known at the time of Auerbach’s invention [see Aravamudan, column 1 «lines 37-39»]. One would have been motivated to provide such a combination so as to increase the functionality of Auerbach’s system.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571.272.3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Dohm Chankong/  
Examiner, Art Unit 2452